

From: Goodman, Wendy

Sent: 3/28/2012 6:08:04 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 77411069 - THE STOKED - RJ  
Museum - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 77411069.doc

# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77411069

MARK: THE STOKED



**CORRESPONDENT ADDRESS:**

LISA N KAUFMAN  
LAW OFFICE OF LISA N KAUFMAN PA  
2807 POINCIANA CIRCLE  
COOPER CITY, FL 33026

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Ron Jon Surf Shop of Fla., Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

RJ Museum

**CORRESPONDENT E-MAIL ADDRESS:**

lnktm@hotmail.com

## EXAMINING ATTORNEY'S APPEAL BRIEF

### **Issue on Appeal**

Applicant has appealed the Trademark Examining Attorney's refusal to register the mark THE STOKED for the following goods and services in Classes 18, 25 and 35:

Class 18: Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags for sale at the owner's museum stores which are devoted to the board sports industry, both in the museum itself and online;

Class 25: Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos for sale at the owner's museum stores which are devoted to the board sports industry, both in the museum itself and online; and

Class 35: Retail gift shop services and on-line retail gift shop services provided at the owner's board sports museum stores, featuring: clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts.

Registration was refused under Trademark Act § 2(d), 15 U.S.C. § 1052(d), because applicant's mark, when used on or in connection with the identified goods and services in Classes 18, 25 and 35, so resembles the marks in Registration No. 2,822,074 for STOKED and Registration No. 3,545,367 for STOKED as to be likely to cause confusion, to cause mistake, or to deceive.

### **Procedural History**

On March 3, 2008, applicant, Ron Jon Surf Shop of Fla., Inc., applied to register the standard character mark THE STOKED on the Principal Register for goods and services identified, as:

- Class 6: Metal key chains, metal bottle openers
- Class 9: decorative magnets, sunglasses and cases therefor
- Class 18: Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags
- Class 25: Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos
- Class 35: Retail gift shop services and on-line retail gift shop services featuring clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts
- Class 41: Museum services

In an Office Action dated June 26, 2008, registration was refused under Trademark Act 2(d) based on Registration Nos. 2,822,074 and 3,331,656. In addition, the examining attorney provided information regarding a prior-filed pending application, Serial No. 78/917548, which could prove to be a bar to registration. Applicant was also required to amend the identification of goods and services in Classes 6 and 35. In its response dated October 6, 2008, applicant amended the identifications in Classes 6 and 35. In addition, applicant presented arguments in support of registration. On October 30, 2008, the application was suspended pending the disposition of the prior-filed pending application. The refusal to register under Section 2(d) was maintained and continued.

On June 17, 2009, the Examining Attorney issued a Non-Final Office Action refusing registration under Trademark Act 2(d) based on the then newly matured Registration No. 3,545,367. The previous refusal was maintained and continued. Applicant failed to timely respond to this Non-Final Office Action and the application was abandoned for failure to respond. On January 17, 2010, applicant filed a Petition to Revive based on the claim that the failure to timely respond was unintentional. On that same date, the Petition to Revive was granted. Applicant included a Response to the Office Action in its Petition to Revive, presenting arguments in support of registration.

On February 28, 2010, the Examining Attorney made final the refusal to register under Trademark Act 2(d), based on Registration Nos. 2,822,074 and 3,545,367. The refusal to register based on Registration No. 3,331,656 was withdrawn. On August 27, 2010, Applicant filed a Notice of Appeal. On this same date, Applicant also filed a Request for Reconsideration After Final Action, in which it presented arguments in

support of registration, as well as amended the identification of goods and services to narrow the channels of trade to “sale through Applicant’s museum stores, both in the museum itself and online.” On October 13, 2010, the Examining Attorney denied applicant’s Request for Reconsideration, as to Classes 18, 25 and 35, but withdrew the refusal to register with respect to Classes 6 and 9.

On October 20, 2010, appeal proceedings resumed. On December 9, 2010, Applicant requested an extension of time to file its appeal brief. This request was granted and Applicant was given until January 18, 2011 to file its brief. On January 13, 2011, Applicant filed a Request for Remand to file additional evidence to support registration of the proposed mark and to, again, amend the identification of goods and services to further narrow the channels of trade. Applicant’s Request for Remand was granted. The case was remanded to the Examining Attorney on January 19, 2011.

On March 13, 2011, the Examining Attorney issued a Non-Final Office Action to address the identification of goods and services which were unacceptable, as amended. In addition, the Examining Attorney considered Applicant’s new evidence to support registration, but was not persuaded, maintaining her final refusal to register as to Classes 18, 25 and 35. Applicant responded on September 12, 2011, amending the identification of goods and services, as required. Applicant presented additional arguments, and related evidence, in support of registration. On October 30, 2011, the Examining Attorney issued a Continued Final Office Action in which the amended identification of goods and services were accepted, and the final refusal to register under Trademark Act 2(d), as to Classes 18, 25 and 35, was maintained and continued. On December 19, Applicant requested an Extension of Time to File Appeal Brief. This request was granted.

Applicant filed its appeal brief on February 3, 2011. The appeal proceedings were resumed.

## **Argument**

### **Likelihood of Confusion**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of

confusion. TMEP §1207.01(d)(ii); *e.g.*, *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and

Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an *ex parte* proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression.

*In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re*

*International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian*

*Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). The examining attorney

must resolve any doubt regarding a likelihood of confusion in favor of the prior

registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

## **I. Similarity of Marks**

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988); In re Lamson Oil Co., 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. In re West Point-Pepperell, Inc., 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Applicant's mark, THE STOKED, is highly similar, in fact, nearly identical, in sound, spelling, appearance, and commercial impression to the mark used in the cited

prior registrations, STOKED. However, it is Applicant's position that the Examining Attorney is disregarding the significance of "THE" in the proposed mark. Applicant's Brief, at page 8. Applicant argues that "THE" creates a "memorable trademark" because it is an unusual combination of a an article and adjective or verb. Applicant's Brief, at page 9. This unusual combination, contends Applicant, creates a different commercial impression from STOKED standing alone. Applicant's Brief, at page 10.

The only difference between the proposed mark and the registered marks is the article THE which has no trademark significance whatsoever and does nothing to obviate the potential for confusion. When comparing similar marks, the Trademark Trial and Appeal Board has found that inclusion of the term "the" at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE "virtually identical" marks; "[t]he addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS "virtually identical" marks; the inclusion of the definite article "the" is "insignificant in determining likelihood of confusion"). *See also Bank of Am. Nat'l Trust & Savings Ass'n v. First Nat'l Bank of Allentown*, 220 USPQ 892, 896 (TTAB 1984) (finding TIME\$AVER and THE TIME\$AVER STATEMENT to be "confusingly similar" marks); *Dog House Inc. v. Dawg House, Inc.*, 138 USPQ 466, 467 (TTAB 1963) (finding DAWG HOUSE and design and THE DOG HOUSE and design to be "substantially similar" marks).

Furthermore, the mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii).

Applicant contends that when viewed in the context of its goods and services, which are limited to the board sports industry, the proposed mark is suggestive, and as such "weak." Further to this point, Applicant argues that the proposed mark will have significant meaning to its customers because of the association between the term STOKED and the board sports community. This significance or association, according to the applicant, will avoid any likelihood of confusion with the registered marks.

Applicant's Brief, at pages 11-12.

Despite applicant's arguments to the contrary, the term STOKED is simply not weak in connection with the identified goods and services, even as amended. Applicant

contends that the Examining Attorney is disregarding the significance of the word STOKED in the context of the board sports industry. The Examining Attorney has not disregarded the significance; rather, it is the Examiner's position that the meaning/significance of the term STOKED to the surfing community does nothing to overcome this refusal. The word STOKED is defined by mainstream dictionaries, such as *The American Heritage Dictionary*® and *Merriam-Webster's*®, as “exhilarated and excited.” “Stoked” may be a common term used among surfers, but the term also has meaning and use outside of the surf community. The slang term is used by surfers and non-surfers, alike, to describe an emotion. The following are a few examples:

Fergie ‘*stoked*’ to rock the 2011 Kids’ Choice Awards. ([www.sify.com](http://www.sify.com))

Justin Bieber Shocked, Then *Stoked* about Grammy Noms. ([www.mtv.com](http://www.mtv.com))

C.J. Spiller *Stoked* about ‘Madden’ Debut. ([www.espn.go.com](http://www.espn.go.com))

See evidence attached to the Non-Final Office Action dated March 13, 2011. Applicant has provided additional evidence consisting of a page from an online publication, “The Word Detective,” describing the origins of the word STOKED. This evidence does not persuade the examiner that the proposed mark is weak in connection with the identified goods and services.

Applicant has submitted printouts of third-party registrations for marks containing the wording STOKED to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services. See *Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d

1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982).

The third party registrations and pending applications, upon which Applicant relies, are easily distinguished. Registration Nos. 3,682,624 (FOREVER STOKED), 3,871,189 (STOKED RACING), and 3,836,244 (WAY STOKED) are all compound word marks. The additional term in each mark creates a distinctly different commercial impression from the mark in the cited registrations which is simply STOKED. Registration No. 3,619,197 (STOKED SKATEBOARDS) is for completely unrelated goods, and is, thus, irrelevant to this analysis. Application Serial No. 77/625057 (GET STOKED) is not yet registered. It is also irrelevant to this analysis because the services are completely unrelated to applicant's services. Finally, Application Serial No. 85/175915 (STOKED SURFWEAR) has been abandoned for failure to respond to a refusal to register under Trademark Act 2(d), citing Registration No. 2,822,074, just as the Examining Attorney cited, here, against the proposed mark.

Assuming arguendo, that the marks at issue are weak, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

## **II. Similarity of Goods and Services**

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. In *re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); see, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. In *re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii).

Applicant's goods and services, as amended:

Beach bags, tote bags, back packs, cinch sacks, ruck sacks, and book bags for sale at the owner's museum stores which are devoted to the

board sports industry, both in the museum itself and online;

Men's, women's and children's clothing and sportswear namely, sweatshirts, sweat pants, sweat shorts, shirts, bathing suits, dresses, blouses, skirts, beach cover-ups, sandals, socks, headbands, caps, hats, visors, wet suits, jackets and ponchos for sale at the owner's museum stores which are devoted to the board sports industry, both in the museum itself and online; and

Retail gift shop services and on-line retail gift shop services provided at the owner's board sports museum stores, featuring: clothing and accessories; beach and surf gear; sporting and recreational goods, equipment and accessories; toys and games; household goods; stationery products, greeting cards, postcards, note cards, books and publications, posters, calendars, planners, journals; and novelty and souvenir items and gifts,

are closely related to the goods identified in the cited registrations, that is:

ankle bracelets, bracelets, charms, chokers, earrings, identification bracelets, jewelry chains, necklaces, pendants, rings, watches (Reg. No. 3,545,367);

all-purpose carrying bags, backpacks, beach bags, change purses, clutch purses, daypacks, duffel bags, evening handbags, fanny packs, handbags, key cases, make-up bags sold empty, multi-purpose purses, overnight bags and cases, pocketbooks, purses, rucksacks, satchels, shoulder bags, tote bags, waist packs (Reg. No. 3,545,367); and

sportswear, namely, t-shirts, hats, jackets, swim trunks, pants and shorts (Reg. No. 2,822,074).

Many of Applicant's goods are, in fact, *identical* to the Registrants' goods, namely:

backpacks, beach bags, rucksacks, tote bags, hats and jackets.

First, the USPTO's X-Search database includes a large number of third-party marks registered for use in connection with the same or similar goods and services as those of both Applicant and Registrants in this case. The Examining Attorney has

provided a representative sample of these registrations as evidence. See Final Office Action, dated February 28, 2010. This evidence shows that the goods and/or services listed therein, namely, a variety of bags, clothing items, jewelry and retail services selling the same, are of a kind that may emanate from a single source under a single mark. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii)

The following are a few examples:

Registration No. 3,706,961, SILVER SLIPPER and Design, for bags including: tote bags and beach bags, clothing including: hats, jackets, pants, t-shirts, and retail stores featuring clothing, bags and totes;

Registration No. 3,486,249 5F, for bags including: tote bags, clothing including: pants, shorts, hats, and jackets, and retail store services specializing in clothing and accessories;

Registration No. 3,308,793, Design, for clothing including: jackets, pants and shorts, bags including: backpacks and beach bags, and retail store services featuring bags and clothing;

Registration No. 3,726,765, PAUL FRANK, for bags including: backpacks and tote bags, clothing including: t-shirts, pants, jackets, shorts and hats, and retail clothing store; and

Registration No. 3,207,487, FERNBANK for tote bags, shirts, caps, jackets and retail gift shops

Second, Applicant has restricted the channels of trade of its goods to: “for sale at the owner's museum stores which are devoted to the board sports industry, both in the museum itself and online” and of its services to: “services provided at the owner's board sports museum stores.” However, this restriction does not obviate a likelihood of

confusion in this case. If the cited registrations contain no limitations as to their channels of trade or classes of purchasers, then it is presumed that the registrant's goods move in all normal channels of trade and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). In this case, registrants' goods contain no limitations as to their channels of trade and may be sold anywhere, including applicant's museum stores.

Furthermore, the Examining Attorney has provided evidence that demonstrates that it is common for the retail store of a museum to sell goods other than promotional items for the museum, itself. This evidence includes web pages from the online stores of The Phillips Collection, The Museum of Modern Art, The Art Institute of Chicago, The Museum of Fine Arts, Boston and The Field Museum. Denial of Request for Reconsideration, dated October 13, 2010. In each example, the museum sells jewelry, clothing and a variety of bags that are not promoting the particular museum. In fact, in most cases, these goods are manufactured by third parties and sold by the museum stores simply because such items might be of interest to the museum store customers.

Additionally, items sold at museum stores are, in many cases, also sold by stores/retailers unrelated to museums. The evidence of record includes web pages from the websites of surfing museums which show that such museums sell items, such as books and DVDs about surfing, which a consumer can also purchase at Barnes & Noble®, Target® and Amazon.com®. One such museum, the Texas Surf Museum, sells a novelty "Woody" wind spinner which one can purchase from online retailers, unrelated to surf museums. In addition, the Examining Attorney has provided evidence that

demonstrates that items sold at art and history museums are also sold by third party retailers. For instance, The Smithsonian Store sells a Rawlings® leather wallet that is manufactured by and sold by Rawlings®, as well. The Smithsonian Store sells a Tiffany lamp inspired umbrella which can also be purchased from Walmart®. The Museum of Modern Art sells a “Tord Boontje” charm necklace; as does a seller on Amazon. Non-Final Office Action dated March 3, 2011.

Applicant argues that visitors to its museums will make purchases to “enhance their museum experience and to possess some memento from the museum as a reminder of their museum visit.” Applicant’s Brief, at page 19. Applicant goes on to explain that a museum goer who purchases a wallet or Tiffany style umbrella at the Smithsonian museum does so because s/he wishes to own that wallet or umbrella, and not to “memorialize their experience” at the museum. Applicant’s Brief, at pages 19-20. Applicant’s contention is not supported by evidence; it is simply an assumption about visitors to museums and how or why they make the purchases they do from museum stores. Perhaps some museum visitors purchase items in museum stores to savor their museum experience; but, others might make purchases in a museum store -- as they would in any retail store -- simply because they like the items. It is Applicant’s position that visitors to its museums and museum stores will not be confused if/when they happen upon the registered marks in other retail establishments because these visitors/consumers will know that the museum and the goods sold in the museum store share the same name, and, as such, goods sold under the registered marks must come from a different source. Applicant’s Brief, at page 21. This is a leap unsubstantiated by evidence. Even if a consumer understands the connection between the name of Applicant’s museum and a

product sold in Applicant's museum store with the same name, this understanding does not prevent the consumer from being confused when seeing same/similar goods with a nearly identical trademark in a traditional retail establishment. Applicant is overlooking the fact that consumers know that items sold in museum stores are also sold in other traditional retail establishments.

### **Conclusion**

In conclusion, it is the Examining Attorney's position that the marks at issue are highly similar, that Applicant's goods and services are closely related to the goods identified in the cited registrations, and that any doubt as to the issue of likelihood of confusion must be resolved in favor of the prior registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191, 200-01 (TTAB 1979).

For the foregoing reasons, it is respectfully submitted that the refusal to register under Trademark Act § 2(d) should be affirmed.

Respectfully submitted,

/Wendy B. Goodman, Esq./  
Trademark Attorney  
Law Office 109  
(571) 272-9276 (phone)  
wendy.goodman@uspto.gov

Dan Vavonese  
Managing Attorney  
Law Office 109